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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,647	09/24/2001	Jean-Jacques Claisse	CLAISSE=2	6513

7590 11/30/2007

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EXAMINER	
NORDMEYER, PATRICIA L	
ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
11/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/960,647	CLAISSE ET AL.	
	Examiner	Art Unit	
	Patricia L. Nordmeyer	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *30,31,33,34,36,37,39,40,42-45,47 and 49-60* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *30,31,33,34,36,37,39,40,42-45,47 and 49-60* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Repeated Rejections

1. The 35 U.S.C. 102(b) rejection of claims 30, 36, 39, 43, 44, 47 and 49 as anticipated by DeBaratolo, Jr. et al. (USPN 5,300,731) in the office action dated July 12, 2007 is repeated as Applicant's arguments in the response dated October 10, 2007 are found to be unpersuasive. The rejection is repeated below for Applicant's convenience.

DeBaratolo, Jr. et al. disclose an electrical wiring trunking (Figure 1) comprising a cover (Figure 1, #28) and a base portion (Figure 1, #22), said base portion being constituted by a thermoplastics material section (Column 4, lines 16 – 17) having a U-shaped cross section (Figure 1, #22) and comprising a substantially flat wall having two longitudinal edges and two flanges each extending transversely to said wall and each joined to a respective longitudinal edge of said wall (Column 5, line 64 to Column 6, line 2), wherein said wall contains a longitudinal succession of mechanically weakened areas (Figure 1, #94), each mechanically weakened area being a precursor for a hole having a closed periphery (Figure 1, #94; Column 6, line 22 – 42), and each hole precursor is a closed contour formed by a succession of through-openings located along the periphery of the hole or a blind hole whose bottom is constituted by a continuous web, wherein the contour is formed by a succession of blind openings, grooves, along the hole periphery (Figure 1, #94; Column 6, line 22 – 42) as in claims 30, 36, 39, 43, 44, 47 and 49.

2. The 35 U.S.C. 103(a) rejection of claims 31, 33, 34, 37, 40, 42, 45 and 50 over DeBaratolo, Jr. et al. (USPN 5,300,731) in view of Gehrs et al. (USPN 5,444,183) in the office

action dated July 12, 2007 is repeated as Applicant's arguments in the response dated October 10, 2007 are found to be unpersuasive. The rejection is repeated below for Applicant's convenience.

DeBaratolo, Jr. et al. disclose an electrical wiring trunking (Figure 1) comprising a cover (Figure 1, #28) and a base portion (Figure 1, #22), said base portion being constituted by a thermoplastics material section (Column 4, lines 16 – 17) having a U-shaped cross section (Figure 1, #22) and comprising a substantially flat wall having two longitudinal edges and two flanges each extending transversely to said wall and each joined to a respective longitudinal edge of said wall (Column 5, line 64 to Column 6, line 2), wherein said wall contains a longitudinal succession of mechanically weakened areas (Figure 1, #94), each mechanically weakened area being a precursor for a hole having a closed periphery (Figure 1, #94; Column 6, line 22 – 42), and each hole precursor is a closed contour formed by a succession of through-openings located along the periphery of the hole or a blind hole whose bottom is constituted by a continuous web, wherein the contour is formed by a succession of blind openings, grooves, along the hole periphery (Figure 1, #94; Column 6, line 22 – 42). However, DeBaratolo, Jr. et al. fail to disclose each hole precursor having an oblong shape, each hole precursor is a through-hole surrounded by a continuous annular web having a thickness that is less than that of said wall and wherein at least some of said hole precursors are adapted to receive a fixation screw.

Gehrs et al. teach each hole precursor is a through-hole surrounded by a continuous annular web having a thickness that is less than that of said wall (Column 2, lines 43 – 46)

in a thermoplastic enclosure (Column 2, lines 34 – 36) for the purpose of being able to selectively remove desired sections from the enclosure (Column 2, lines 57 – 60).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the hole precursor is a through-hole surrounded by a continuous annular web having a thickness that is less than that of said wall in DeBaratolo, Jr. et al. in order to be able to selectively removed desired sections from the enclosure as taught by Gehrs et al.

With regard to the limitation of "each hole precursor having an oblong shape", it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape that would have been unforeseen or even an unforeseen result to one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the hole precursor. One skilled in the art would have been motivated to do so in order to vary the item that could be inserted through the precursor. MPEP 2144.04.

With regard to the limitation of "at least some of said hole precursors are adapted to receive a fixation screw", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 51 – 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBaratolo, Jr. et al. (USPN 5,300,731).

DeBaratolo, Jr. et al. disclose an electrical wiring trunking (Figure 1) comprising a cover (Figure 1, #28) and a base portion (Figure 1, #22), said base portion being constituted by a thermoplastics material section (Column 4, lines 16 – 17) having a U-shaped cross section (Figure 1, #22) and comprising a substantially flat wall having two longitudinal edges and two flanges each extending transversely to said wall and each joined to a respective longitudinal edge of said wall (Column 5, line 64 to Column 6, line 2), wherein said wall contains a longitudinal succession of mechanically weakened areas (Figure 1, #94), each mechanically weakened area being a precursor for a hole having a closed periphery (Figure 1, #94; Column 6, line 22 – 42), and each hole precursor is a closed contour formed by a succession of through-openings located along the periphery of the hole or a blind hole whose bottom is constituted by a continuous web,

wherein the contour is formed by a succession of blind openings, grooves, along the hole periphery (Figure 1, #94; Column 6, line 22 – 42). However, DeBaratolo, Jr. et al. fail to disclose the base portion have two opposed ends and is open and wherein said thermoplastics material section has a constant cross section.

With regard to the limitations of "the base portion have two opposed ends and is open and wherein said thermoplastics material section has a constant cross section", it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape that would have been unforeseen or even an unforeseen result to one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the base portion. One skilled in the art would have been motivated to do so in order to vary the item that could be inserted through the base portion. MPEP 2144.04.

Response to Arguments

5. Applicant's arguments filed October 10, 2007 have been fully considered but they are not persuasive.

6. In response to applicant's arguments, the recitation of electrical wiring trunking has not been given patentable weight because the recitation occurs in the preamble. A preamble is

generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The body of the claim provides the structure of the element; therefore, the preamble is not being given patentable weight

In response to Applicant's argument that the adapter does not have a U-shaped cross section along its entire length, Figure 1 clearly shows that the base portion (#22) clearly has a U-shaped cross section along its entire length.

In response to Applicant's argument that the DeBaratolo et al. fails to disclose said wall contains a longitudinal succession of mechanically weakened areas, DeBaratolo et al. does disclose said wall contains a longitudinal succession of mechanically weakened areas (Figure 1, #94). The openings extend along the entire wall of the part, thereby forming the needed succession of weakened openings.

In response to Applicant's argument that the DeBaratolo et al. fails to disclose a blind hole having a bottom constituted by a continuous web, each hole precursor of DeBaratolo et al. is a closed contour formed by a succession of through-openings located along the periphery of the hole or a blind hole whose bottom is constituted by a continuous web, wherein the contour is

formed by a succession of blind openings, grooves, along the hole periphery (Figure 1, #94; Column 6, line 22 – 42).

In response to Applicant's argument that the DeBaratolo et al. fails to disclose the base portion being thermoplastic material, said base portion of DeBaratolo et al. is constituted by a thermoplastics material section (Column 4, lines 16 – 17).

In response to Applicant's argument that the advantages of the oblong holes is its easy adjustment of the wiring trunking relative to the associated fastening elements, the application does not indicate any new, significant attributes of the invention due to its shape that would have been unforeseen or even an unforeseen result to one of ordinary skill in the art.

In response to Applicant's argument that none of the references teach a through hole surrounded by a web, Gehrs et al. does disclose that the center section of the hole would be removed for attachment, which would form a through hole surrounded by a web as disclosed by the claimed invention.

With regard to the argument of the prior art not teaching "at least some of said hole precursors are adapted to receive a fixation screw", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Both DeBaratolo

et al. and Gehrs et al. disclose that the center section may be punched out, forming precursors that can receive a screw.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Examiner
Art Unit 1794

pln